

REMARKS

In the aforementioned Office Action claims 1-11 were objected to because of formalities. Those formalities that appeared in claims 1 and 8 have been corrected. Since the other claims were rejected via their dependency it is believed that claims 1-13 are now in proper form for allowance.

In the aforementioned Office Action claims 1-8 were rejected under 35 U.S.C. 103(a) as being unpatentable over Sarkozi (U.S. Patent No. 5,138,774) in view of Swartz et al. (U.S. Patent No. 6,346,210) and Healy et al. (U.S. Patent No. 5,951,935). In making that rejection the Examiner recognized that Sarkozi does not expressly teach imprinting a patient's foot to identify a patient's footprint and high pressure areas on the bottom of the foot, that the lining element 10 is multidensity and fabricated from a mold of the foot, and that the base pad 20 is a softer hardness than the first insert material. The Examiner went on to state Swartz teaches making a foot pad 50 with different densities by imprinting the foot against the foam (the lining element 10 is multidensity and fabricated from a mold of the foot; imprinting a patient's foot to identify a patient's footprint and high pressure areas on the bottom of the foot). The Examiner concludes it would have been obvious to one of ordinary skill in the art at the time the invention was made to use Swartz's method to make adjustable Sarkozi's lining element 10 in order to absorb shock.

The Examiner went on to argue that Healy teaches a sock liner member 30 with elastomeric pads 32, 34 that are softer than the sock liner member 30 (the base pad 20 is a softer hardness than the first insert material) (see col. 2, lines 36-46 and col. 3, lines 8-13). The Examiner then concludes it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply Healy's softer elastomeric pads as the base pad 25 of Sarkozi in order to have excellent cushioning, shock absorption, and energy return (see Healy, col. 1, lines 25-35).

In rejecting claims 1-8 the Examiner combines a sock liner with an insole with removable height adjustable stackable support pads in order to reject a method for manufacturing custom fit

therapeutic footwear that is based on a Doctor's prescription. It is Applicant's contention that a person of ordinary skill in the art in therapeutic footwear would not turn to socks and height adjustable stackable support pads in developing a therapeutic shoe. Accordingly, it is Applicant's contention that the rejection under 35 U.S.C. 103 should be withdrawn.

In the present rejection the Examiner has overlooked an important step of partially filling the area of reduce thickness in the first insert with a mass of a second insert material to thereby provide a custom molded insert with the combination.

Further, claims 12 and 13 call for partially filling the area of reduced thickness in the first insert material with a cut out portion of the second insert material and subsequently dispensing shoes and custom inserts to the patient and wherein steps a, b, c and i are performed in the office of a license professional practitioner and steps d, e, f, g and h are performed in a laboratory for manufacturing custom fit inserts. It addition, claim 13 calls for all of the elements of claim 12 which includes a step of adding a pad of said first insert material around the area of reduced thickness. It is Applicant's contention that this concept is not disclosed or taught by the cited references.

Claims 9, 11 and 13 were rejected under 35 U.S.C. 103 as being unpatentable over Sarkozi (5,138,774) in view of Swartz et al. (6,346,210) and Healy et al. (5,951,935) and further in view of Brown (U.S. Patent No. 3,995,002). It is respectfully submitted that in making this rejection, the Examiner has not met the duty of *prima facie* obviousness as set forth in Section 2142 of the Manual of Patent Examining Procedure. As set forth therein:

to reach a proper determination under 35 U.S.C. 103, the Examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the Examiner must then make a determination when the claimed invention "as a whole" would have been obviousness at the time to that person.

Knowledge of Applicant's disclosure must be put aside in reaching this determination yet kept in mind in order to determine the "differences", conduct a search and evaluate the subject matter as a whole.

It is Applicant's contention that in the present instance the Examiner has not evaluated a combination of all of the steps claimed by Applicant as a whole in reaching a determination of obviousness. Accordingly, the rejection under Section 103 should be reversed. Further, as set forth in Section 2142:

with regard to rejections under 35 U.S.C. 103, the Examiner must provide evidence which as a whole shows that the legal determination sought to be proved (i.e. the reference teachings establish a prima facie case of obviousness) is more probable than not.

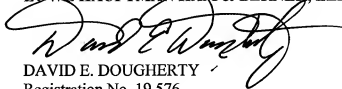
As set forth in *In re Rouffet* 47 USPQ2nd1453 ...an Examiner may often find every element of the claimed invention in the prior art. If identification of each claimed element of the prior art were sufficient to negate patentability, very few patents would ever issue. Further, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an Examiner to use the claimed invention itself as blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate" process by which to determine patentability (cite omitted). As stated in the aforementioned decision the suggestion to combine requirement is a safeguard against the use of hindsight to negate patentability.

In the present instance the Examiner has selected elements from four United States Patents separated by many years in order to negate patentability. It is Applicant's contention that Applicant has claimed a unique combination of steps and that when considered as a whole, the claims should be allowed.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read "David E. Dougherty", is written over the printed name.

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Date: October 15, 2008
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